



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,183	05/31/2001	Melissa K. Carpenter	094/004D	3768
22869	7590	01/15/2004	EXAMINER	
GERON CORPORATION 230 CONSTITUTION DRIVE MENLO PARK, CA 94025			FALK, ANNE MARIE	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/872,183

Applicant(s)

CARPENTER, MELISSA K.

Examiner

Anne-Marie Falk, Ph.D.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-46 is/are pending in the application.
- 4a) Of the above claim(s) 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-42 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1201.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1632

### DETAILED ACTION

The response filed November 3, 2003 has been entered.

Claims 21-46 are pending in the instant application.

Applicant's election with traverse of Group I, Claims 21-42 and 46 in the response filed November 3, 2003 is acknowledged. The elected invention is drawn to a method for producing a neural cell population from human embryonic stem cells.

Claim 43-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Applicant timely traversed the restriction requirement in the response filed November 3, 2003. Applicants argue that the inventions of Groups I and II are not patentably distinct because the claims of Group II require the user to conduct the procedure recited in Claim 21 (Group I). However, distinctness is not determined by claim format but rather by the relationship between the different inventions. In the instant case, inventions I and II are drawn to materially different methods that require different starting materials, different modes of operation, and produce different effects. Applicants also argue that, upon determination that Claim 21 is free of the prior art, then Claims 43-45 will necessarily also be free of the prior art. However, the Examiner makes no assumption that Claim 21 is free of the art. Moreover, being free of the prior art does not mean that an invention is patentable. Each of the inventions of Groups I and II requires consideration of separate issues relating to assessment of novelty, obviousness, utility, written description, and enablement. Furthermore, the searches for the inventions of Groups I and II are not coextensive. Thus, search and examination of both inventions in a single patent application constitutes a serious burden on the Examiner and Claims 43-45 will not be rejoined with the claims of Group I.

Art Unit: 1632

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-42 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-42 and 46 are indefinite in their recitation of "culturing progeny of the ES cells" because it is unclear what the starting material is. The term "progeny of the ES cells" covers a wide variety of different cell types. Since ES cells are by definition totipotent their "progeny" covers all cell types. However, the specification indicates that the starting material for producing the neural cell population recited in the claims are the human ES cells themselves and not their progeny. Clarifying claim language is required.

Claim 29 is indefinite in its recitation of "propagating progeny of the hES cell line as cell aggregates" because it is unclear if this is referring to the starting material or the product of Claim 21.

***Conclusion***

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (571) 272-0728. The examiner can normally be reached Monday through Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (571) 272-0734. The central official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to William Phillips, whose telephone number is (703) 305-3482.

Anne-Marie Falk, Ph.D.

*Anne-Marie Falk*  
ANNE-MARIE FALK, PH.D.  
PRIMARY EXAMINER